

REMARKS

By this Amendment, claims 37-59 are cancelled without prejudice or disclaimer, and claims 60-76 are newly added. Therefore, claims 60-76 are pending in the application.

No new matter has been added.

The claim rejections of record are rendered moot by the present claim amendments.

Consideration and allowance of all claims are respectfully requested in view of the following remarks, which include a discussion of prior art of record.

- The claimed fish landing apparatus improves over conventional lights by uniquely providing a structure that is adaptable, modular, and that is able to be optimized by minimizing the weight and space needed for a lighted, collapsible landing net apparatus.

The prior art references of record, alone or in combination, fail to teach or suggest the claimed fish landing apparatus that includes a plurality of telescoping sections that include a net attachment section, and a self-contained light body for illuminating a net, the light body having: an LED; a rotary switch lens rotatably attached to the light body; a disc type battery providing electric power; and a radially-aligned contact pair opened or closed by rotation of the rotary switch lens for on/off switching of the electric power to the LED, as claimed in independent claim 60. As a result of the claimed combination, conventional problems of bulky, non-collapsible, heavy, and complicated fish landing apparatus are reduced or eliminated. In particular, a telescoping (and otherwise collapsible) fish landing apparatus illuminates a net portion for landing a fish, without using heavy batteries, remote switches, lengthwise conductors, light tubes, or other complicated and heavy structure.

Since the applied references, alone or in combination, fail to teach or suggest all the claim limitations, the ground of rejection (including any or all of the three references listed in the present claim rejection(s)) does not amount to a *prima facie* case. In order to establish a *prima*

facie case of obviousness, the prior art references must teach or suggest all the claim limitations. MPEP § 2143 *et seq.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *Id.*, citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

The previously-applied grounds of rejection amount to improper hindsight analysis because selected parts of the individual references are being cited without consideration of the invention as a whole. *See In re Wesslau*, 147 USPQ 391, 393 (CCPA 1965) (“impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art”). There is nothing in the applied references to suggest the claimed combination, and it is respectfully submitted that the Examiner's previous statements are unsupported by any reasoning other than that gleaned from Applicant's disclosure, and selected parts of the individual references are being cited without consideration of the invention as a whole. *In re Wesslau, supra*.

The previous grounds of rejection also appear to have relied on unsupported statements that refer to the level of skill in the art. However, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 50 USPQ2d 1161 (Fed. Cir. 1999), cited in MPEP § 2143.01.

Thus, there would have been no suggestion or motivation to have combined the references. In order to further prosecution, Applicants offer the following distinguishing remarks.

The claimed combination of limitations is new and unique, and is not taught or suggested by the applied references.

One skilled in the art, in view of the prior art of record, would not have been motivated to have achieved the claimed combination of limitations. Rather, these references teach away from the claimed combination as a whole. In particular, the *Hersom* reference discloses a handle 24 that is not collapsible, that contains weighty conventional batteries 46 in a remote battery end 28 of handle 24, a switch 40 that is remote from other elements, an electrical assembly 30 located in still another location of handle 24, a heavy step-up transformer 48 and other heavy components (e.g., Figs. 1 and 2). Such a structure is not able to be modified to a collapsible and lightweight structure that avoids distribution of structural elements, as is claimed. In re Gordon, *supra*. The *Shin* reference discloses a miniature bulb 38 powered by conventional batteries 15 in a heavy structure not readily adaptable to a use in a fish landing apparatus. In addition, *Shin* does not teach or suggest anything regarding a use of an LED for illumination. The references of record teach away from the claimed structure because the Examiner's proposed combinations would change the respective principles of construction of these references. In re Ratti, 123 USPQ 349, 352 (CCPA 1959), cited in MPEP § 2143.02. Accordingly, the references of record teach away from what is claimed. In re Gordon, 221 USPQ 125 (Fed. Cir. 1984); MPEP 2143.01.

The *Tanikuro*, *Everett*, *Hansen*, and *McIntyre* references do not teach or suggest what is claimed, and are also not adaptable for the proposed modification.

Claims 61-76 are patentable at least by virtue of their respective dependencies from independent claim 60.

Request for Interview

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly **requested to call** the undersigned at the telephone number listed below.

Amendment under 37 C.F.R. § 1.111
Application Serial No. 10/699,519

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 10-0270.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'JW Bain', is written over a horizontal line.

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